

The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

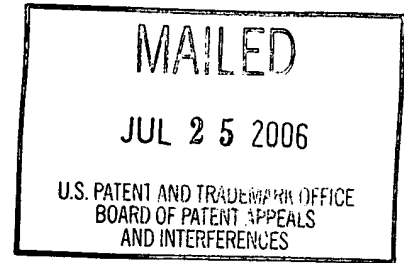
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ROBERT LAWTON, THOMAS PATRICK O'CONNOR, JR.,
BARBARA ANN BARTOL, and PAUL SCOTT M^{AC}HENRY

Appeal No. 2005-1593
Application No. 10/054,647

HEARD: November 17, 2005



Before MILLS, GRIMES and GREEN, Administrative Patent Judges.

MILLS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is a decision on appellants' request for rehearing of our earlier decision entered December 23, 2005, wherein we affirmed the examiner's final rejection of claims 1 through 13 under 35 U.S.C. § 102 as unpatentable over Rikihisa. Decision, pages 15-18.

Claim 1 is illustrative of the claims on appeal and reads as follows:

1. A composition of matter comprising an isolated polypeptide consisting essentially of SEQ ID NO:2 or a phenotypically silent amino acid substitution variant thereof that specifically binds to an anti-*Ehrlichia* antibody.

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The prior art reference cited by the examiner is:

Rikihisa et al. (Rikihisa)

WO 99/13720

Mar. 25, 1999

Grounds of Rejection Maintained

Claims 1-13 stand rejected under 35 U.S.C. § 102(a), as anticipated by Rikihisa.

DISCUSSION

We find no error in our Decision of December 23, 2005 and therefore, we decline to grant the relief requested or change our earlier decision in any way.

First, we address the procedural issue raised by appellants. Appellants argue that the Board is in error for failing to consider claims 10-13 individually. Request for Reconsideration (Request), page 5. Appellants argue that they “did indeed argue claims 10-13 separately. See, Reply Brief, pages 16-17.” Request, page 5.

We find no merit in appellants’ argument. Nowhere in the Appeal Brief did appellants separately argue claims 10-13 with respect to the § 102 rejection over Rikihisa. See, pages 13-16 of Appeal Brief. According to 37 C.F.R. § 41.37 (2005), pertaining to the structure and contents of the “Appeal Brief”,

[w]hen multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.

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Appellants failed to separately argue claims 10-13 with respect to the § 102 rejection over Rikihisa in the Appeal Brief, and thus waived any argument that the Board must consider the patentability of these claims separately.

Appellants further direct the Board's attention to treatment of claims 7-8 in Appeal No. 2005-1610. We remind appellants that, "[e]ach case must be judged on its own facts." Intervet America Inc. v. Kee-Vet Laboratories Inc., 887 F.2d 1050, 1055, 12 USPQ2d 1474, 1478 (Fed. Cir. 1989). We further note that claims 7-8 were not rejected in view of the prior art by the examiner in Appeal No. 2005-1610.

In sum, appellants failed to separately argue claims 10-13 with respect to the § 102 rejection over Rikihisa in the Appeal Brief, and thus waived any argument that the Board must consider the patentability of these claims separately.

With respect to the merits of the appeal, appellants request that we read portions of the description and features from the specification into the claims. Request, page 6. We decline to do so.

Appellants now argue that the specification indicates that adding additional amino acids "to the claimed polypeptides ... would be detrimental to the sensitivity and specificity of assays for the detection of Ehrlichia antibodies." Request, pages 7-8. However, appellants chose not to use the transitional phrase "consisting of" in the claim

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which would have precluded the addition of amino acids to the claimed sequence. “A ‘consisting essentially of’ claim occupies a middle ground between closed claims that are written in a ‘consisting of’ format and fully open claims that are drafted in a ‘comprising’ format.” PPG Industries v. Guardian Industries, 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 1998). Thus, appellants’ claim scope is, by definition, at least broader than the SEQ ID NO:2 sequence itself. Moreover, absent a clear indication in the specification or claims of what the basic and novel characteristics of the claimed polypeptide actually are, the term “consisting essentially of” is construed as equivalent to “comprising.” See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355.¹

Appellants have not defined in the specification the claim scope or scope of the invention proscribed by the claim term “consisting essentially of.” We remind appellants that it is their burden to precisely define the invention, not the PTO’s. In re Morris, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997). Appellants always have the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550- 51 (CCPA 1969).

¹ In re Crish, 393 F.3d 1253, 1256, 73 USPQ2d 1364,1367 (Fed. Cir. 2004) was cited in the Decision for the comparative proposition that when a specific sequence is interpreted in view of “comprising” claim language, additional amino acids are possible at either end of the sequence.

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Appellants have asserted a characteristic of the isolated polypeptide and its variants is its ability to bind to an anti-Ehrlichia antibody. Appellants have the burden to show that the introduction of additional components would materially change the characteristics of their invention or whether such components are excluded from their claims. In re De Lajarte, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). Appellants have not met this burden. Appellants have not shown that whole Ehrlichia proteins encompassed by the claim scope do not have the ability to bind to an anti-Ehrlichia antibody, a characteristic of the sequence and sequence variants appellants have claimed. Appellants have not recited a specific sensitivity and/or specificity for the polypeptide of SEQ ID NO:2 in the claims to distinguish the claimed sequence from whole Ehrlichia proteins.

We decline to import limitations from the specification that are not part of the claim into the claims before us, as requested by appellants. The Request for Reconsideration is denied.

CONCLUSION

Therefore, the request for reconsideration is denied.

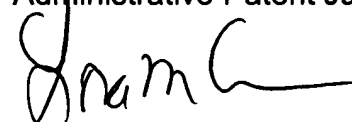
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No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

REHEARING DENIED


DEMETRA J. MILLS
Administrative Patent Judge


ERIC GRIMES
Administrative Patent Judge


LORA M. GREEN
Administrative Patent Judge

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